

## **REMARKS**

### **I. Overview**

These remarks are set forth in response to the Non-Final Office Action. Presently, claims 1 through 9 are pending in the Patent Application. Claims 1, 5 and 9 are independent in nature. In the Non-Final Office Action, claims 1, 3 through 5, 7 and 8 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0019755 by Kagami. Further, claims 2, 6 and 9 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kagami in view of U.S. Patent No. 5,978,770 to Waytena et al. (Waytena). In response, Applicant respectfully traverses the rejections on the art.

### **II. The Applicants' Invention**

The Applicant has invented a computer-implemented automated interactive method for matching an open appointment to a client. In the Applicant's method, a client list of at least one client having a scheduled appointment can be electronically generated with the caveat that client requires a different appointment than the scheduled appointment. An appointment list of at least one open appointment time slot can be generated and the client list can be correlated to the appointment list in order to generate a contact list. In this regard, the contact list contains at least one appointment option based on the client and the open appointment time slot. Thereafter, the appointment option can be electronically communicated to the client such that the appointment option has a time of availability that is different than the scheduled appointment. Finally, the appointment option can be selected by the client to fill the at least one open appointment time slot.

III. Rejections Under 35 U.S.C. § 102(b) and 103(a)

A. Characterization of Kagami

Kagami discloses a system and method for scheduling appointments for beauty salons using communication environments such as the internet. The Kagami system also prevents false appointments which are foreseen as being a possible problem when enabling appointments with beauty salons to be made over such a communication environment. In particular, the Kagami system includes a memory device for storing a work schedules of a beauty salon and a data communication device for exchanging data with customers. The Kagami system also includes a central processing device for updating the work schedule based on appointment requests made by the customers such that when a customer makes an appointment request, the appointment request is sent directly to the central processing device if the appointment request includes an identification number pre-assigned to the customer. However, if the appointment request does not include an identification number, the customer is asked to input an address whereby the customer can be contacted by the data communication device, and the appointment request is sent to the central processing device only after the address is inputted. Finally, the appointment information that is prepared on the basis of the appointment request made by the customer is sent to the customer by the data communication device

B. Traversal of the Rejections on the Art

1. The Law of Anticipation

The factual determination of anticipation under 35 U.S.C. § 102 requires the identical disclosure, either explicitly or inherently, of each element of a claimed invention in a single

reference.<sup>1</sup> Moreover, the anticipating prior art reference must describe the recited invention with sufficient clarity and detail to establish that the claimed limitations existed in the prior art and that such existence would be recognized by one having ordinary skill in the art.<sup>2</sup> Absence from an allegedly anticipating prior art reference of any claimed element negates anticipation.<sup>3</sup>

“Both anticipation under § 102 and obviousness under § 103 are two-step inquiries. The first step in both analyses is a proper construction of the claims. ... The second step in the analyses requires a comparison of the properly construed claim to the prior art.”<sup>4</sup> During patent examination, the pending claims must be “given their broadest reasonable interpretation consistent with the specification,”<sup>5</sup> and the broadest reasonable interpretation of the claims must also be consistent with the interpretation that those skilled in the art would reach.<sup>6</sup> Therefore, the Examiner must (i) identify the individual elements of the claims and properly construe these individual elements,<sup>7</sup>, and (ii) identify corresponding elements disclosed in the allegedly

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<sup>1</sup> In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997) (“To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently”), In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226,

1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).

<sup>2</sup> See In re Spada, 911 F.2d 705, 708, 15 USPQ 1655, 1657 (Fed. Cir. 1990); Diversitech Corp. v. Century Steps Inc., 850 F.2d 675, 678, 7 USPQ2d 1315, 1317 (Fed. Cir. 1988).

<sup>3</sup> Kloster Speedsteel AB v. Crucible, Inc., 793 F.2d 1565, 1571 (Fed. Cir. 1986)(emphasis added).

<sup>4</sup> Medicchem, S.A. v. Rolabo, S.L., 353 F.3d 928, 933 (Fed. Cir. 2003) (internal citations omitted).

<sup>5</sup> In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007) (“[T]he PTO must give claims their broadest reasonable construction consistent with the specification. Therefore, we look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation.”); In re Hyatt, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000).

<sup>6</sup> In re Cortright, 165 F.3d 1353, 1359, 49 USPQ2d 1464, 1468 (Fed. Cir. 1999)

<sup>7</sup> See also, Panduit Corp. v. Dennison Mfg. Co., 810 F.2d 1561, 1567-68 (Fed. Cir. 1987) (In making a patentability determination, analysis must begin with the question, “what is the invention claimed?” since “[c]laim interpretation, . . . will normally control the remainder of the decisional process”); see Gechter v. Davidson, 116 F.3d 1454, 1460 (Fed. Cir. 1997) (requiring explicit claim construction as to any terms in dispute).

anticipating reference and compare these allegedly corresponding elements to the individual elements of the claims.<sup>8</sup> This burden has not been met.

## 2. Application of the Law of Anticipation to the Facts

Applicant's originally filed independent claim 1 provides for a computer-implemented automated interactive method for matching an open appointment to a client. Exemplary claim 1 is reproduced as follows:

1. A computer-implemented automated interactive method for matching an open appointment to a client, comprising:

electronically generating a client list of at least one client having a scheduled appointment, said at least one client requiring a different appointment than said scheduled appointment;

electronically generating an appointment list of at least one open appointment time slot;

correlating said client list to said appointment list to generate a contact list, said contact list containing at least one appointment option based on said at least one client and said at least one open appointment time slot;

electronically communicating said at least one appointment option to said at least one client, said at least one appointment option having a time of availability different than said scheduled appointment; and

electronically selecting said at least one appointment option by said at least one client to fill said at least one open appointment time slot..

Integral to claim 1 is the electronic generation of a client list of at least one client having a scheduled appointment, wherein the client requires a different appointment than the scheduled appointment for the client. This feature cannot be located in Kagami, however.

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<sup>8</sup> Lindermann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.2d 1452, 221 USPQ 481 (Fed. Cir. 1984).

Notwithstanding, on page 2 of the Non-Final Office Action, Examiner refers to paragraph [0025] of Kagami for the foregoing teaching. For the convenience of the Examiner, Paragraph [0025] is reproduced herein in its entirety:

[0025] When an appointment request from a customer conflicts with an appointment which has already been set, the customer is shown conditions such as stylists which are free, or other dates and times which are open and prompted to make a selection, but in this case, appointments which specify the stylist by identification number are interpreted to have a strong preference for the stylist, so that the information is shown in the order of the times and dates for which the designated stylist is free, followed by the times and dates for which appointments can be made with other stylists. Should the data communication means have the ability to do so, these may of course be displayed simultaneously.

As it will be apparent from paragraph [0025], Kagami teaches the determination that a requested appointment conflicts with an existing appointment. Yet, the entirety of paragraph [0025] is devoid of the teaching of a client requiring an appointment that differs from an already scheduled appointment for the client.

In this regard, Examiner's comparison of paragraph [0025] of Kagami to Applicant's critical claim element "client having a scheduled appointment" results in an implicit claim construction of "appointment request" in that the appointment "which has already been set" is not specific to the "customer" and the context of Kagami indicates that the appointment "which has already been set" relates to a different customer. Such a claim construction, however, provides for a broader than reasonable interpretation of the term "client having a scheduled appointment". Specifically, during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification.<sup>9</sup> The Federal Circuit's en banc

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<sup>9</sup> M.P.E.P. 2111.

decision in Phillips v. AWH Corp.<sup>10</sup> expressly recognized that the United States Patent and Trademark Office employs the "broadest reasonable interpretation" standard.

The plain meaning of the term "client having a scheduled appointment" is a client that has a scheduled appointment such that in the context of claims 1, 5 and 9, a client whom already has a scheduled appointment seeks to schedule a replacement appointment. Applicant's usage of the term "client having a scheduled appointment" is consistent with the ordinary meaning as evidenced by paragraph [0013] of Applicant's published specification set forth as follows:

[0013] In the preferred embodiment, automated interactive matching system 10 generates a list of clients through Generate Client List Step 12. Such a listing of clients, such as patients of a physician, dentist, or veterinarian, client-customers of a vehicle service facility, or the like can be generated from the existing computer network of the facility implementing the present invention. It is preferred that the clients already have existing appointments, such as periodic check-ups (such as a mammogram or physical) or interval services (such as an oil change), and that such clients would prefer an earlier or later appointment if such earlier or later appointment is feasible.

Examiner, however, provides no patentable weight or consideration to the phrase "having a scheduled appointment" and instead construes the critical claim term as only "a client requesting an appointment". Examiner's improper claim construction of "client having a scheduled appointment" exceeds the bounds of the law by providing a broader than reasonable

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<sup>10</sup> 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005)(The Patent and Trademark Office ("PTO") determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction "in light of the specification as it would be interpreted by one of ordinary skill in the art." In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must "conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description." 37 CFR 1.75(d)(1).)

interpretation of a critical claim element inconsistent with the usage of the claim term " client having a scheduled appointment " within Applicant's specification.<sup>11</sup>

3. Conclusion

In that important limitations of all of the claims are lacking in the combination of Kagami and Waytena, the Applicant respectfully requests the withdrawal of the rejections under 35 U.S.C. §§ 102(b) and 103(a) owing to the clearly distinctive nature of Applicant's invention as recited in unamended claims 1, 5 and 9. The Applicant requests that the Examiner call the undersigned if clarification is needed on any matter within this Amendment, or if the Examiner believes a telephone interview would expedite the prosecution of the subject application to completion.

Respectfully submitted,

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<sup>11</sup> In re Schreiber, 128 F.3d 1473, 1477 (Fed. Cir. 1997) ("To anticipate a claim, a prior art reference must disclose every limitation of the claimed invention, either explicitly or inherently"), In re Rijckaert, 9 F.3d 1531, 28 USPQ2d 1955 (Fed. Cir. 1993); Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989); Perkin-Elmer Corp. v. Computervision Corp., 732 F.2d 888, 894, 221 USPQ 669, 673 (Fed. Cir. 1984).